

ESTTA Tracking number: **ESTTA1160542**

Filing date: **09/20/2021**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91244876
Party	Defendant Global Esprit Inc.
Correspondence Address	THOMAS LEE BACON & THOMAS PLLC 625 SLATERS LANE, FOURTH FLOOR ALEXANDRIA, VA 22314 UNITED STATES Primary Email: tlee@baconthomas.com Secondary Email(s): mail@baconthomas.com 703-683-0500
Submission	Rebuttal Brief
Filer's Name	John R. Schaefer
Filer's email	mail@baconthomas.com, jschaefer@baconthomas.com
Signature	/John R. Schaefer/
Date	09/20/2021
Attachments	Applicant Brief.pdf(550118 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Application Serial No. 87/934,992
For the Mark:

KONA81

Published: October 23, 2018

KONA USA, INC.,
Opposer,

v.

GLOBAL ESPRIT INC.,
Applicant.

Opposition No. 91244876

APPLICANT GLOBAL ESPRIT INC.'S BRIEF ON THE CASE

TABLE OF CONTENTS

II. STATEMENT OF FACTS.....	1
A. Applicant’s application for the KONA81 mark.....	1
B. Opposer’s mark KONA is weak.....	2
1. “Kona” refers to Kona, Hawaii, and has a geographical significance	2
2. The geographical significance of “Kona” is relevant to KONA’s goods	4
3. The geographical significance renders KONA commercially weak.....	5
4. Opposer’s sales, advertising, sponsorships and reviews don’t establish strength	6
III. ARGUMENTS.....	7
A. There is no likelihood of confusion between KONA81 and KONA	7
1. Kona, by itself, is a “weak” element in comparison of the marks	7
2. The goods are not identical	10
IV. CONCLUSION.....	13

TABLE OF AUTHORITIES

Cases

<i>Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank</i> , 811 F.2d 1490, 1493, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987).....	11
<i>Coach Servs., Inc. v. Triumph Learning LLC</i> , 668 F.3d 1356, 1370, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012).....	11
<i>Estate of P.D. Beckwith, Inc., v. Comm'r of Patents</i> , 252 U.S. 538, 545-46, 40 S.Ct. 414, 64 L.Ed. 705 (1920).....	7
<i>Fleetwood Co. v. Mende</i> , 49 C.C.P.A. 907, 298 F.2d 797, 799 (1962).....	8
<i>Fossil Inc. v. Fossil Group</i> , 49 U.S.P.Q.2d 1451, 1457 (T.T.A.B. 1998)	6
<i>Hewlett-Packard Co. v. Packard Press Inc.</i> , 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002).....	11
<i>In re Bed & Breakfast Registry</i> , 791 F.2d 157, 159 229 USPQ 818, 819 (Fed. Cir. 1986).....	8
<i>In re Detroit Athletic Co.</i> , 903 F.3d 1297, 1308, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018).....	11
<i>In re E.I. DuPont DeNemours & Co.</i> , 476 F.2d 1357 at 1361.....	7
<i>In re FabFitFun, Inc.</i> , 127 USPQ2d 1670, 1675 (TTAB 2018).....	9
<i>In re Giovanni Food Co.</i> , 97 USPQ2d 1990, 1991 (TTAB 2011)	11
<i>In re Iolo Techs., LLC</i> , 95 USPQ2d 1498, 1500 (TTAB 2010).....	11
<i>In re Red Bull GmbH</i> , 78 USPQ2d 1375, 1378 (TTAB 2006).....	4
<i>In re Thor Tech, Inc.</i> , 90 USPQ2d 1634, 1635 (TTAB 2009).....	9
<i>In re White Swan Ltd.</i> , 8 USPQ2d 1534, 1535 (TTAB 1988).....	9
<i>J & J Snack Foods Corp. v. McDonald's Corp.</i> , 932 F.2d 1460, 1463, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991).....	11
<i>Juice Generation, Inc. v. GS Enters. LLC</i> , 794 F.3d 1334, 1338-40, 115 USPQ2d 1671, 1674-75	

(Fed. Cir. 2015).....	8
<i>Octocom Sys., Inc. v. Houston Computer Servs., Inc.</i> , 918 F.2d 937, 942, 16 USPQ2d 1783, 1787	
(Fed. Cir. 1990).....	11
<i>Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772</i> , 396 F.3d 1369, 1373	
(Fed.Cir.2005).....	8
<i>Paula Payne Prods. Co. v. Johnson Publ'g Co.</i> , 473 F.2d 901, 902, 177 USPQ 76, 77 (C.C.P.A.	
1973).....	11
<i>Stone Lion Capital Partners, L.P. v. Lion Capital LLP</i> , 746 F.3d 1317, 110 USPQ2d 1157, 1162	
(Fed. Cir. 2014).....	11
<i>Tea Board of India v. The Republic of Tea</i>	5
<i>U.S. Shoe Corp. v. Chapman</i> , 229 USPQ 74 (TTAB 1985).....	9
<i>Univ. of Notre Dame du Lac v. J.S. Gourmet Food Imp. co.</i> , 213 USPQ 594, 596 (TTAB 1982),	
aff'd, 703 F.2d 1372 (Fed. Cir. 1982).....	4
<i>Univ. of Notre Dame du Lac v. J.S. Gourmet Food Imp. Co.</i> , 213 USPQ 594, 596 (TTAB 1982),	
aff'd, 703 F.2d 1372 (Fed. Cir. 1982).....	4

Rules

FRE 201(b)(2).....	4
--------------------	---

I. STATEMENT OF THE ISSUES

Whether Applicant's applied-for mark **KONA81** raises a likelihood of confusion with Opposer's mark KONA which consists entirely and solely of the geographical indicator referring to Kona, Hawaii which holds a particular relevance and meaning at least to Opposer's primary line of goods.

II. STATEMENT OF FACTS

A. Applicant's application for the **KONA81** mark

Applicant has applied for registration of the trademark **KONA81**, as a mark consisting of the stylized term "KONA81," appearing as **KONA81**. (Ser. No. 87934992). As the application stands today, the good identified in the application are Bath sandals; Bath slippers; Bathing suits for men; Bathing caps; Bathing costumes; Bathing suits; Bathing trunks; Beach footwear; Beach shoes; Dry suits; Fitted swimming costumes with bra cups; Leather shoes; Parts of clothing, namely, gussets for tights, gussets for stockings, gussets for bathing suits, gussets for underwear, gussets for leotards and gussets for footlets; Protective neck and arm guards made of neoprene or other materials to prevent wetsuit chafing; Rash guards; Rash vests; Sandals and beach shoes; Skating outfits; Ski suits for competition; Ski wear; Skiing shoes; Skirt suits; Snow boarding suits; Sport coats; Sport shirts; Sports caps and hats; Sports jerseys and breeches for sports; Sports jackets; Sports pants; Sports vests; Surf wear; Swim wear; Swim wear for gentlemen and ladies; Swimming caps; Travel clothing contained in a package comprising reversible jackets, pants, skirts, tops and a belt or scarf; Triathlon clothing, namely, triathlon tights, triathlon shorts, triathlon singlets, triathlon suits; Vested suits; Waterproof footwear; Waterproof jackets and pants; Waterproof leather shoes

and boots; Wet suit gloves; Wet suits for water-skiing and sub-aqua; Bottoms as clothing; Pullovers; Shirts; Swimsuits, all in Class 25.

B. Opposer's mark KONA is weak

1. "Kona" refers to Kona, Hawaii, and has a geographical significance

While Opposer argues that "[t]he commercial impression engendered by the mark KONA in connection with bicycles is arbitrary as there is no testimony or evidence that Kona has any geographical significance for bicycles" (34 TTABVUE at pp 14, 15), Opposer concedes that the word "Kona" refers to a coastal region of Hawaii in the western part of the island of Hawaii, asking the Board to take judicial notice of the dictionary definition of Kona, referencing Merriam-Webster's online dictionary at <https://www.merriam-webster.com/dictionary/Kona>. (*Id.*) And, Opposer's own evidence demonstrates a clear geographical significance for bicycles. KONA is clearly not an arbitrary mark.

Referring to Jacob Heilbron's trial testimony, Mr. Heilbron has noted that "several other brands, including TREK, CERVELLO, MARIPOSA, BLUE, FRAMED, LOCO CYCLES, SPEEDVAGEN, INTENSE, FELT and GIANT offer both bikes and cycling apparel." (29 TTABVUE, at ¶ 16). Notable among these is the FELT - Felt Bicycles Company. (*Id.*) Exhibit 31 to Mr. Heilbron's testimony is identified as "[t]rue and correct copies of screen captures of representative pages from the website of Felt Bicycles at www.feltbicycles.com showing the offering of bikes, cycling sports jerseys, and bib shorts, under the FELT mark." (*Id.*)

Referring more closely to Exhibit 31 to Mr. Heilbron's testimony, it is found that FELT sells, among other things, bicycles specialized for triathlon. (29 TTABVUE, Ex. 31). FELT's

website reveals that, not only does FELT advertise triathlon bikes, FELT boasts “the fastest triathlon bikes,” (*Id.*), stating under a heading “THE FASTEST TRIATHLON BIKES” the following:

Triathlon is the convergence of training, mindset, and equipment. You dedicate your time to preparing and putting in those long sessions of double days and swim-run, run-ride combinations. You have the drive and you are committed to performing with your eye-of-the-tiger mentality. You obsess over the details so that you'll be the fastest you. We get it. Our triathlon range is designed for those getting their first "real" dedicated triathlon bike with our B platform and goes up to our flagship IA FRD which carries *the distinction of being the fastest triathlon bike at Kona*. Throughout our line-up, you'll see dialed specs, great riding position adjustability, and an assortment of bikes that'll inspire you to dig deeper in your workouts and on race day. Whether you are tackling a segment PR, *a Kona qualification*, or another World Championship win, we're with you.

(*Id.*)(emphasis added).

Whether or not FELT’s triathlon bikes are actually the fastest is not at issue here. What is relevant is how FELT seeks to back up their claim to the fastest triathlon bikes with specific references to “Kona.” In support of their claim, FELT boasts that their “flagship [model] IA FRD” bicycle “carries the distinction of being the fastest triathlon bike *at Kona*” (*Id.*)(emphasis added). To this, FELT adds that “[w]hether you are tackling a segment PR, a *Kona* qualification, or another World Championship win, we’re with you” (*Id.*) (emphasis added). FELT clearly recognizes a significance to the location of Kona, and has tied their reputation to that of Kona. It must be understood that FELT believes that their customers, too, understand and recognize the significance of “Kona.”

Triathlon is defined by the Merriam-Webster dictionary as “an athletic contest that is a long-distance race consisting of three phases (such as swimming, bicycling, and running).” The

Board may take judicial notice of this definition of “triathlon,”¹ as well as an example of the use of “triathlon” in a sentence provided by Merriam-Webster:

“Her colleagues also credit Ms. Sinema, the first sitting member of Congress to complete an *Ironman triathlon*, with her relentless persistence and focus, even as various developments threatened to sink the talks” (<https://www.merriam-webster.com/dictionary/triathlon> (visited Sept. 14, 2021)(emphasis added). Disregarding any commentary about Congresswoman Sinema, Applicant would draw the Board’s attention to the fact that that Merriam-Webster’s example use of “triathlon” makes particular reference to “an Ironman triathlon.”

2. The geographical significance of “Kona” is relevant to KONA’s goods

Ironman triathlon has a special significance here. The Board is asked to take judicial notice of the well known fact that Kona, Hawaii is the site of an annual Ironman triathlon. And, not just any Ironman triathlon, Kona, Hawaii hosts the Ironman World Championship. Applicant refers the board to the Ironman® website, at <https://www.ironman.com/im-world-championship>.² The TBMP instructs that “The only kind of fact that may be judicially noticed by the Board is a fact that is "not subject to reasonable dispute in that it is either (1) generally known within the territorial jurisdiction of the trial court or (2) capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned.”” (TBMP 704.12(a)). Applicant submits that the

¹ The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.S. Gourmet Food Imp. Co.*, 213 USPQ 594, 596 (TTAB 1982), aff’d, 703 F.2d 1372 (Fed. Cir. 1982), *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006) .

² Federal Rule of Evidence 201 allows a judge to take judicial notice of facts which are “capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned.” FRE 201(b)(2). See *United States v. Bari*, 599 F.3d 176, 180 (2d Cir. 2010). The Board may also take judicial notice of encyclopedia entries, census data, standard reference works and of commonly known facts. TBMP 1208.04.

fact that Kona, Hawaii is the site of an annual Ironman triathlon, and in particular the Ironman World Championship triathlon, is just such a fact, and that the Ironman® website is a source whose accuracy cannot reasonably be questioned with respect to this fact. FELT's reference to Kona in touting the quality of their products demonstrates that this fact is known in the industry, as well.

Hence, the significance of the geographical location of "Kona" is clear. As demonstrated by FELT, a reputation or success gained at "Kona" (that is, the Ironman World Championships triathlon held at Kona) may be understood to contribute to marketing and reputation of FELT's products. FELT's express reference to "Kona" makes clear that the geographic location of Kona, Hawaii does indeed have a clear significance to bicycles, just as it might for other triathlon gear.

3. The geographical significance renders KONA commercially weak

Although no evidence is shown that "Kona" is recognized as a geographical source of the goods in question (although Kona, Hawaii is well known as a geographical source for coffee), it is clear that "Kona" is well descriptive of, and recognized as, a destination for athletes who will use certain of the goods in question. It is clear also that KONA's competitor, FELT Bicycles, finds this recognition of "Kona" as a prominent destination for Ironman® triathletes of such significance that they have used specific reference to "Kona" in marketing their bicycles as having "the distinction of being the fastest triathlon bike *at Kona*" (29 TTABVUE, Ex. 31). "Geographically descriptive terms are generally regarded as inherently weak and entitled to less protection than arbitrary or suggestive marks." *Tea Board of India v. The Republic of Tea*, 80 USPQ2d 1881, 1899 (TTAB 2006). Applicant submits that this clear geographical significance and association, already used by a competitor in describing a quality (indeed, an alleged superiority) of their goods, must be considered, and must be understood to render KONA's mark weak.

4. Opposer's sales, advertising, sponsorships and reviews don't establish strength

Opposer's evidence and assertions of sales, advertising and sponsorships fail to establish a showing of strength of their mark. These assertions stand outside of any meaningful context, such as any showing of overall sales of bicycles in the US, or any showing of actual impact of Opposer's advertising on market share or sales of their products.

“If a party plaintiff in a Board proceeding is to rely simply on sales and advertising figures in an effort to establish that its mark is famous, then it is incumbent upon that party plaintiff to place the sales and advertising figures in context, for example, by showing that the product is the leading product in its category, the second leading product in its category etc.” *Fossil Inc. v. Fossil Group*, 49 U.S.P.Q.2d 1451, 1457 (T.T.A.B. 1998). While evidence of advertising and sales may be relevant to prove the strength of a mark, standing alone without a context, such evidence may not be sufficient to prove that a mark is very strong. That is, the trademark owner should put its sales and advertising figures in perspective by comparing them to the sales and advertising figures for similar products to show that this mark is used on a leading product in its category. *Renaissance Greeting Cards v. Dollar Tree Stores*, 405 F. Supp. 2d 680, 693 n.17 (E.D. Va. 2005) (citing *Fossil Inc.*, at 1457).

Opposer's evidence does not put its sales and advertising figures into any context or perspective by comparing them to the sales and advertising figures for similar products. Indeed, Opposer has not even addressed the size of the relevant market, either in units of sale or dollar figures, let alone shown their own market share or prominence. Rather to the contrary, Opposer has conceded that “Kona is not the only brand in the U.S. market that offers both bikes and cycling-related apparel under the same brand,” and that “several other brands” offer bikes and cycling

apparel, naming nine such competitors. (29 TTABVUE at ¶ 16). No comparison or context is provided, however, relating to market share, volume of sales of these (or other) competitors, or any other benchmark that would put Opposer's sales and advertising figures into any reasonable context showing strength of their mark.

Likewise, Opposer has not presented any evidence showing the effect of their advertising expenditures. No evidence appears to demonstrate any success of Opposer's advertising campaigns, such as demonstrated cause-and-effect between an advertising campaign and a following increase in sales.

Opposer has failed to establish commercial strength on the basis of their sales, advertising and sponsorships.

III. ARGUMENTS

A. There is no likelihood of confusion between **KONA81** and KONA

1. Kona, by itself, is a "weak" element in comparison of the marks

Applicant, of course, concedes that the word "Kona" is common to both Applicant's mark **KONA81** and Opposer's mark KONA. However, marks are to be compared in consideration of each of their "appearance, sound, connotation and commercial impression. *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357 at 1361. "The commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail." *Estate of P.D. Beckwith, Inc., v. Comm'r of Patents*, 252 U.S. 538, 545-46, 40 S.Ct. 414, 64 L.Ed. 705 (1920).

Applicant submits that in the present case, their applied-for mark **KONA81** is distinctive in

each of appearance, sound, connotation and commercial impression, and particularly so when the word “Kona” is appropriately given minimal weight in comparison of the marks. Because the word “Kona” by itself, as a “weak” element, should be afforded little weight, and comparison of the two marks made in view of other aspects or elements of the marks, the overall appearance must dominate over the mere recognition that both marks include (indeed, Opposers mark consists solely of) the word “Kona.”

The weaker an opposer's mark, the closer an applicant's mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1373 (Fed.Cir.2005); *Fleetwood Co. v. Mende*, 49 C.C.P.A. 907, 298 F.2d 797, 799 (1962) (“Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights.”).

If the common element of two marks is "weak" in that it is generic, descriptive, or highly suggestive of the named goods or services, it is unlikely that consumers will be confused unless the overall combinations have other commonality. *See, e.g., Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338-40, 115 USPQ2d 1671, 1674-75 (Fed. Cir. 2015) (remanded for consideration of whether and to what degree the phrase PEACE & LOVE was suggestive or descriptive in the food-service industry); *In re Bed & Breakfast Registry*, 791 F.2d 157, 159 229 USPQ 818, 819 (Fed. Cir. 1986) (reversing TTAB’s holding that contemporaneous use of BED & BREAKFAST REGISTRY for making lodging reservations for others in private homes, and BED & BREAKFAST INTERNATIONAL for room booking agency services, is likely to cause confusion, because, inter alia, the descriptive nature of the shared wording weighed against a finding that the

marks are confusingly similar); *In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1675 (TTAB 2018) (holding I'M SMOKING HOT for cosmetics and related non-medical personal care items and SMOKIN' HOT SHOW TIME for cosmetics not likely to cause confusion based on a totality of the evidence showing that the shared wording is somewhat weak in view of its suggestiveness and that the marks overall convey different commercial impressions); *U.S. Shoe Corp. v. Chapman*, 229 USPQ 74 (TTAB 1985) (holding COBBLER'S OUTLET for shoes, and CALIFORNIA COBBLERS (in typed and stylized forms) for footwear and women's shoes, not likely to cause confusion). TMEP 1207.01(b)(viii).

Similarity of marks in one respect – sight, sound, or meaning – does not automatically result in a finding of likelihood of confusion even if the goods are identical or closely related; rather, the rule is that, taking into account all of the relevant facts of a particular case, similarity as to one factor alone may be sufficient to support a holding that the marks are confusingly similar. *See In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988). In the present case, the only similar element is the word “Kona” which must be given only minimal weight.

As a threshold matter, visually comparing the marks side-by-side, they look different. Simply stated, **KONA81** looks different from Opposers KONA. Even considering the common use of the word Kona, the marks clearly differ in appearance. Applicant submits, moreover, that the common use of the word Kona should be given little weight, since Kona has a geographical significance and therefore KONA is a weak mark.

Minimally weighting the word “Kona” itself in comparison of the marks, other aspects will

dominate. Considering **KONA81** in comparison to KONA, distinguishing features of **KONA81** include the stylized fonts and addition of the number 81 to the word Kona. Side by side, it is easy to distinguish the marks from one another in light of these features alone. Notably, Applicant's **KONA81** is depicted in two fonts - a letter font perhaps evocative of an east Asian or pacific island character, and the differently appearing 81. The evocative letter font of the word Kona, together with the strikingly different font for the number 81, give Applicant's mark **KONA81** a striking appearance clearly distinct from Opposer's KONA.

Additionally, considering the sound of the two marks in comparison, **KONA81** (pronounced kona-eighty-one) is phonetically dominated by "eighty-one" - weighting the phrase according to syllables, **KONA81** consists of five full syllables (ko-na-eight-y-one), wherein "eighty-one" constitutes three of the five. In comparison, Opposer's mark KONA only consists of two syllables (ko-na), leaving the "eighty-one" included in Applicant's mark a phonetically dominant element. Moreover, Opposer's mark must be given little weight in comparison, because of its geographically descriptive nature.

2. The goods are not identical

Opposer's statement that "Opposer has continuously used the KONA mark in connection with the same goods listed in the '992 Application" is overly broad, at best. Mr. Heilbron is quoted as stating that Opposer "has also continuously used the KONA mark in the U.S. on or in connection with apparel, including sports jerseys and shorts *for cycling* since, through its predecessor TBG, at least as early as 1990" (34 TTABVUE at p. 9 (emphasis added), identifying only goods for cycling. Applicant's application, however, includes no reference to apparel, or anything else, *for cycling*.

The nature and scope of a party's goods or services must be determined on the basis of the goods or services recited in the application or registration. See, e.g., *In re Detroit Athletic Co.*, 903 F.3d 1297, 1308, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018); *Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1370, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1463, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991); *Octocom Sys., Inc. v. Houston Computer Servs., Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1493, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); *Paula Payne Prods. Co. v. Johnson Publ'g Co.*, 473 F.2d 901, 902, 177 USPQ 76, 77 (C.C.P.A. 1973); *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1500 (TTAB 2010). TMEP 1207.01(a)(iii).

However, while Opposer refers to apparel, including sports jerseys and shorts *for cycling*, no such reference to cycling is made in the applied-for listing of goods. The goods identified in the **KONA81** application include: Bath sandals; Bath slippers; Bathing suits for men; Bathing caps; Bathing costumes; Bathing suits; Bathing trunks; Beach footwear; Beach shoes; Dry suits; Fitted swimming costumes with bra cups; Leather shoes; Parts of clothing, namely, gussets for tights, gussets for stockings, gussets for bathing suits, gussets for underwear, gussets for leotards and gussets for footlets; Protective neck and arm guards made of neoprene or other materials to prevent wetsuit chafing; Rash guards; Rash vests; Sandals and beach shoes; Skating outfits; Ski suits for competition; Ski wear; Skiing shoes; Skirt suits; Snow boarding suits; Sport coats; Sport shirts;

Sports caps and hats; Sports jerseys and breeches for sports; Sports jackets; Sports pants; Sports vests; Surf wear; Swim wear; Swim wear for gentlemen and ladies; Swimming caps; Travel clothing contained in a package comprising reversible jackets, pants, skirts, tops and a belt or scarf; Triathlon clothing, namely, triathlon tights, triathlon shorts, triathlon singlets, triathlon suits; Vested suits; Waterproof footwear; Waterproof jackets and pants; Waterproof leather shoes and boots; Wet suit gloves; Wet suits for water-skiing and sub-aqua; Bottoms as clothing; Pullovers; Shirts; Swimsuits, all in Class 25.

Notably, none of the goods are apparel, or anything else, for cycling. It is worth noting that this identification reflects the Board's Dec. 7, 2020 decision granting Opposer's Motion for Partial Summary judgment - several goods are already removed from the application.

Opposer attempts to conflate alleged cross marketing of Applicant's goods with goods relevant to their mark to tie Applicant's goods to Opposer's bicycle apparel, noting that Applicant has described certain men's swimwear as "perfect for all sport activities, including running, biking, yoga, gym fitness and etc." (34 TTABVUE at p. 11). On the other hand, Opposer has conceded that, as of February, 2021, "Applicant had only offered certain select items of apparel (swimwear) under its applied for mark." (34 TTABVUE at p. 20). Even Opposer understands that Applicant's goods are directed to swimwear and not cycling apparel, notwithstanding how some customers may chose to wear their apparel. Notably, Mr. Heilbron singles out "cycling-related apparel items" as those that he alleges are "likely to be associated with Kona." (29 TTABVUE at ¶ 32). Nothing among Applicant's applied for list of goods states, or suggests bicycles or cycling apparel, and none of the listed goods give rise to any likelihood of confusion.

IV. CONCLUSION

Opposer's mark KONA is a weak mark. The KONA mark consists solely of the word "Kona," which as a geographic significance rendering the mark inherently weak. Moreover, Opposer's evidence of sales and advertising is not sufficient to establish strength of the mark - Opposer's evidence lacks any context to show that the mark stands out in the market place. Because KONA is a weak mark, other aspects than the single common word must be considered in comparison of the marks. Upon such comparison, Applicant's mark **KONA81** is clearly distinctive and recognizably different from Opposer's mark.

Opposer has failed to demonstrate that Applicant's mark is likely to cause confusion with Opposer's mark **KONA81**. Applicant requests that the Board deny the Opposition.

DATED September 20, 2021

BACON&THOMAS, PLLC

By: /s John R. Schaefer/

John R. Schaefer

jschaefer@baconthomas.com

Attorneys for Applicant Global Esprit, Inc.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of this document is being served on Opposer by emailing it on the undersigned date addressed to the correspondence address of record in the TTABVUE database at the website of the U.S. Patent and Trademark Office as follows.

Sheila Fox Morrison
Steven E Klein
Davis Wright Tremaine LLP
1300 S.W. Fifth Avenue, Suite 2400
Portland, OR 97201-5610
Tel: (503) 778-5311
Fax: (503) 778-5299
sheilafoxmorrison@dwt.com
stevenklein@dwt.com
pdxmtenforcement@dwt.com

Date: September 20, 2021

/s John R. Schaefer/
John R. Schaefer